

Applicants' argument that the cited references do not disclose or suggest an anode having the second catalyst composition required by the rejected claims.

REMARKS

Claims 1-6 and 8-42 are pending in the present application. Claims 12, 15-19 and 23 have been allowed. Claim 30 has been indicated as being allowable if rewritten in independent form including the limitations of its base claim and any intervening claims. Claim 7 was cancelled in a previous amendment, and its subject matter was incorporated into amended claim 1.

Pending claims 1-6 and 8-42 define anodes having first and second catalyst compositions (or methods or apparatuses relating to such anodes). The second catalyst composition comprises a metal oxide as a catalyst. It is the inclusion of this metal oxide that makes the anode more tolerant of voltage reversal.

In the Office Action dated August 13, 2002, claims 1, 3-6, 8-11, 13, 14, 20-22, 33, 34 and 40-42 were finally rejected under 35 U.S.C. §102(a) as being anticipated by Narayanan et al. U.S. Patent No. 5,945,231. Claims 1-3, 24, 25, 28 and 31-42 were again rejected under 35 U.S.C. §102(a) as being anticipated by Narayanan et al. U.S. Patent No. 6,171,721. Claims 26, 27

and 29 were again rejected under 35 U.S.C. §103(a) for obviousness in view of the Narayanan '721 patent.

In response to the final Office Action, applicants pointed out in an after-final submission that Narayanan '231 does not disclose an anode having a second catalyst composition which is a metal oxide. In the after-final submission, Applicants also requested that the finality of the rejection be withdrawn, since the subject matter of claim 7 (having then been incorporated into amended claim 1) had not previously been rejected in view of the Narayanan '721 patent.

The November 21, 2002 Advisory Action indicated that Applicants' request for reconsideration had been considered but did not place the application in condition for allowance. The Advisory Action stated:

Applicant is correct that claim 7 had not been previously rejected in view of '721, however, when incorporated into claim 1, the limitations were met by the teachings set forth in the rejection. More specifically, the rejection explains that the catalysts includes mixtures of two or more catalysts, and that the catalyst can be selected from platinum and ruthenium mixtures.

(Advisory Action, page 2). The Advisory Action apparently contended that previous rejection(s) had determined that the Narayanan '721 patent contained a disclosure of the required second catalyst composition recited in claim 7 (cancelled in favor of amended claim 1 incorporating the limitations of claim 7). The Advisory Action did not, however, identify the disclosure in the Narayanan '721 patent of a second catalyst composition that includes comprises a metal oxide (in addition to a first catalyst composition), as recited in each of the rejected claims.

The Advisory Action instead stated that the catalyst can be selected from platinum and ruthenium mixtures, but this overlooks applicants' limitation, namely: the second catalyst composition must be a metal oxide.

None of the Office Actions issued in connection with the present application identified any disclosure or suggestion in the Narayanan '721 patent of an anode that comprises two different compositions, in which the second composition is a metal oxide. The Office Action dated January 15, 2002, apparently conceded this, since claim 7 as originally filed was not rejected in view of the Narayanan '721 patent. Applicants therefore submit that the Narayanan '721 patent cannot

anticipate or render obvious the applicants' pending claims because it contains has no disclosure or teaching of an anode that comprises two different compositions and in which the second composition is a metal oxide.

Similarly, the Narayanan '231 patent nowhere discloses or suggests an anode having two different catalyst compositions and in which the second catalyst composition is a metal oxide. The passage at column 10, lines 63-68 of the Narayanan '231 patent, which was cited in the support of the final rejection, describes each of Narayanan's Pt-Ru and Pt-RuO₂ compositions as being an alloy (that is, a single composition) and not a combination of two or more discrete catalyst compositions. In this regard, Narayanan's Pt-RuO₂-zeolite/Pt-RuO₂-ZrO₂ is a single catalyst composition (Pt and RuO₂ on a zeolite or zirconia support), not two different catalyst compositions in which the second catalyst composition is a metal oxide.

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In view of the foregoing preliminary remarks, applicants submit that claims 1-6, 8-11, 13, 14, 20-22, 24-29 and 31-42 are allowable, in addition to claims 12, 15-19 and 23 already allowed and claim 30 already indicated as being allowable. The

Examiner is invited to telephone the applicants' undersigned attorney at (312) 775-8202 if any unresolved matters remain.

A Petition for One-Month Extension of Time accompanies this submission, as well as a check for \$110.00 to cover the requisite fee for extension within the first month. Applicants submit that extensions of time in this instance should be calculated from the November 21, 2002 mailing date of the Advisory Action rather than from the August 13, 2002 mailing date of the final rejection. If, however, the present submission and accompanying Request for Continued Examination are not considered to be timely filed within the first month's extension period, then applicants hereby petition for the appropriate additional extension of time that would make the present submission and Request for Continued Examination timely filed.

Please charge any such additional extension fees, as well as any other necessary fees, and credit any overpayment, incurred in connection with this submission and Request for Continued Examination to Deposit Account No. 13-0017.

FROM McANDREWS, HELD, & MALLOY

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